

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

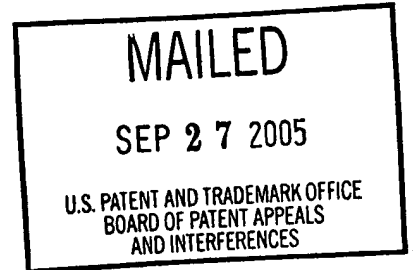
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY J. KONECNI
and
GIRISH A. DIXIT

Appeal No. 2005-1240
Application 08/988,686

ON BRIEF



Before, WALTZ, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

REMAND TO THE EXAMINER

A review of the record presently before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner, via the Office of Director of the involved Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

A summary of part of the prosecution history is set forth herein. An Appeal Brief was filed on May 22, 2001, followed by the filing of a Supplemental Appeal Brief filed on April 19, 2002. In response thereto, an Examiner's Answer was mailed on July 17, 2002. In response to this Examiner's Answer, a Reply Brief was filed on September 4, 2002. A Remand was mailed on August 20, 2003. The Remand instructed that the examiner verify

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that the appellants received an English translation of Japanese Patent document No. 04-171744 (Masanori). The Remand indicated that, not until Paper No. 28 (dated November 19, 2002), is it indicated in the record that an English translation was provided. This date was after the filing date of appellants' Reply Brief on September 4, 2002.

In response to the Remand, the examiner filed a Supplemental Examiner's Answer (Paper No. 34, mailed March 18, 2004). In the Supplemental Examiner's Answer, the examiner indicates that an attempt to contact appellants' attorney, Mr. J.M. Cantor, was made, but was unsuccessful. The examiner indicates that a telephone call was then made to Texas Instruments in Texas. Mr. Jim Brady of Texas Instruments verified that a copy of the English language translation of Masanori had been received and placed in the application file at Texas Instruments. The examiner indicates that Mr. Brady confirmed that Mr. Cantor had access to the file. Supplemental Examiner's Answer, page 2. The examiner also indicates that a copy of the full English translation was mailed to appellants on November 19, 2002. The examiner states that since receipt of the translation by appellants has been confirmed, appellants have been given an opportunity to respond to the contents of the full translation. Supplemental Examiner's Answer, page 2.

In response to the Supplemental Examiner's Answer, appellants filed a second Reply Brief on May 13, 2004. On page 1 of the Reply Brief, Mr. Cantor indicates that he did receive a copy of the translation mailed November 19, 2002, which was received in Texas on November 26, 2002.

On page 2 of the Reply Brief, Mr. Cantor states that, of greater importance, is the fact that the translation was mailed to appellants on November 19, 2002, as indicated in the Remand mailed August 20, 2003. This date was subsequent to the filing

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of the Reply Brief filed on September 4, 2002. Appellants state that it follows that the translation is not of record in this appeal and that in order for the translation to be of record, it is necessary that the examiner withdraw the final rejection and make the English translation of record in proper manner.

Appellants state that in the present record, the translation has never been applied during prosecution, has never been considered by counsel for appellants, and will not be considered until properly made of record.

We fully appreciate the examiner's attempts and time taken in an effort to clarify the record regarding appellants' receipt of the full English translation, as described on pages 2-3 of the Supplemental examiner's answer.

However, the fact remains that an English translation was not provided to appellants until after the Reply Brief was filed on September 4, 2002. Hence, as indicated in our Remand mailed August 20, 2003, we lack the views of both the examiner and appellants, those most knowledgeable of the technology and prosecution, with regard to the critical evidence (full English translation).

Hence, we do not have a proper basis for our review at this point in time. See Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001). We also hesitate to make our own fact findings with regard to the English translation at this point in time. See, In re Sujeet Kumar, 418 F.3d 1361, __ USPQ2d __ (Fed. Cir. 2005).

We appreciate the examiner's comments made at the top of page 3 of the Supplemental Examiner's Answer, that the claims are not patentable over either the abstract or the English translation, of Masanori. However, it is the full English translation that is needful of review by not only the examiner, but by the appellants also.

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We therefore remand this application to the examiner so that both sides have an opportunity to review the full English translation in taking positions. In so doing, we authorize the examiner to introduce the full English translation officially into the record. If reliance upon the English translation in any way constitutes a new ground of rejection, we authorize the examiner to reopen prosecution of the application. Otherwise, we authorize the examiner to file a Supplemental Examiner's Answer wherein the full English translation is relied upon. In this way, there is no doubt that appellants have been given an opportunity to respond to positions taken with regard to the full English translation.


This remand is made pursuant to 37 CFR § 41.50(a)(1) and (2) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

REMAND

Thomas A. Waltz
Administrative Patent Judge


Catherine Timm
Administrative Patent Judge

Beverly A. Pawlikowski
Administrative Patent Judge

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